APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,162	12/05/2003	Eric Walker	03-026	8570

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EXAMINER
FABER, DAVID

ART UNIT	PAPER NUMBER
2178	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 February 2010*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,5,6,8-10,12 and 16-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,5,6,8-10,12 and 16-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some *   c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This office action is in response to the Request for Continued Examination filed

on 11 May 2010.

This office action is made Non Final.

2.   Claims 1, 5-6, 8-10 and 16-17 have been amended.

3.   Claims 2-4, 7, 11, and 13-15 have been cancelled.

4.   Claim 22 has been added.

5.   The rejection of Claims 1, 3-4, 6-8, 10, 16-18, and 20-21 under 35 U.S.C. 102(b)

as being anticipated by Coloring.com has been withdrawn as necessitated by the

amendment. The rejection of Claims 2, 5, 9, 12, 15, and 19 under 35 U.S.C. 103(a) as

being unpatentable over Coloring.com in further in view of Sams Publishing has been

withdrawn as necessitated by the amendment.

6.   Claims 1, 5-6, 8-10, 12, and 16-22 are pending. Claims 1, 6, 10 and 16 are

independent claims

Specification

7.   The specification is also objected to as failing to provide proper antecedent basis

for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

Correction of the following is required: The phrase "computer readable media" is not

found to have proper antecedent basis in the specification; however it is necessary to

use this terminology in order to properly define the claim within the boundaries of

statutory subject matter. In order to overcome the object, an amendment to the

specification is necessary constituting a non-exhaustive statement of what the phrase

"computer readable media" would be as it would have been known to one of ordinary

skill in the art at the time of the invention, in order to verify that the term "computer

readable medium" could not be taken in the context of non-statutory subject matter.

Claim Rejections - 35 USC § 101

8.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent therefor,
> subject to the conditions and requirements of this title.

9.   Claims 6, 8-9, 18 and 20 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter. Claim 6 discloses a system having

a server wherein the specification discloses the server has a memory. However, the

specification discloses the memory may be an array. Its unclear within the specification

if the array is supposed to be viewed as hardware or software. In addition, the use of

the word "array" does not inherently mean that claim is directed to a physical machine.

Therefore, the array is viewed as software and not hardware. Claim 18 and 20 discloses

a computer readable medium; however, the claims and/or specification fail to disclose if

the medium or indicates any hardware therefore the device is representing a data

structure. Thus, the claims lack the necessary physical articles or objects to constitute a

machine or a manufacture within the meaning of 101. The claims appear to be claiming

"software systems" i.e. systems without hardware indication, which is a computer

program per se; therefore, appearing non-statutory.

Any claim not specifically addressed, above, is being rejected as its failure to overcome the incorporated deficiencies of a claim upon which is depends on.

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11.   Claims 1, 6, 8, 10, 16-18, are 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Coloring.com (Coloring.com, "Coloring.com - free online interactive coloring pages and coloring books", pp 1-27, 28-31) in further view of Curts ("Microsoft Word - Drawing Tools', p1-4, published as early as March 27, 2003)

Examiner provides printouts (pp5-6) that Microsoft Word - Drawings Tools publication showing the features had been publicized as early as March 27, 2003.

As per independent claim 1, Coloring.com discloses a method comprising:

- associating a first color and second color with a markup language element capable of accepting pattern fill content, (pp 6, 7, 8, 9-16,17-18: discloses a web site, using a browser, having the ability to show markup elements (pp 6, list of the images or graphics the user may choose), wherein each markup element is an graphic or image being shown capable of being separately shown to the user (pp 8 discloses on embodiment) of receiving colors (color is

an attribute of an image, thus content) from the palette on the left menu of
colors. PP 9-16, and 18 discloses the source code behind the web page of
the markup language element (graphic or image) wherein in its visual form,
displaying a graphic or image that contain many patterns and shapes used to
form a visual figure, which a person is capable of identifying, e.g. a rabbit on
pp 8, on a different colored background. The code written in HTML enables
the graphic or image to accept colors. In addition, a user can choose among
the colors on the palette to the left .(pp 8, 17) In addition,. Pp17 discloses an
image contains multiple shapes that capable of being pattern filled by a color
within each shape. (pp 20-22 discloses an example of pattern filling with a
color of a element on the image))

- applying a grayscale image as pattern fill content of the element, the
grayscale image containing multiple color tones based on the combination of
a first component color and a second component color, the first component
color set to the first color and the second component color set to the second
color (Coloring.com discloses "grayscale" images wherein the only two colors
shown are white and black. Thus, the graphic/image is made up by the
combination of the two component colors, black and white. White makes up
the area of each shape, while black makes up the outline of the patterns,
shapes or graphic/image. Thus, the grayscale image is used as content for
the element shown in pp 8, 17 of the web page.

- displaying at least the element to a user, the multiple color tones of the grayscale image pattern fill content rendered based on a combination of the first component color and the second component color; (pp 8,17 discloses the element being displayed to the user showing the combination of the component colors)

- allowing the user to select respective first colors from a plurality of colors to be applied to the first component color, updating the first color associated with the element with the selected first color, and displaying at least the element to a user, the multiple color tones of the grayscale image pattern fill content rendered based on a combination of the first component color and the second component color, the first component color set to the updated first color (17, 20, 22: pp17 shows the image containing multiple shapes capable of being pattern fill by a new component color. A user selects a color on the color palette on the menu on the left. Then once the color has been selected, the user clicks on a pattern of a portion of the image to fill it with the selected color. Doing so fills the up that portion or pattern with that color shown in pp 20-22. This functionality replaces the portion of the content containing the first component color (white) with a new component color selected from the palette, thus pattern fill)

However, Coloring.com fails to specifically disclose allowing the user to select respective second colors from a plurality of colors to be applied to the second component color, updating the second color associated with the element with the

selected second color, displaying at least the element to a user, the multiple color tones

of the grayscale image pattern fill content rendered based on a combination of the first

component color and the second component color, the second component color set to

the updated second color. On the other hand, Curts discloses a feature in Microsoft

Word that lets you change the line color around the shape. The user is displayed a

palette of colors that allows the user to change the line color of the shape. Once the

user selects the desired color, it would change the line color from the previous color to

the new selected color. (Page 2)

It would have been obvious to one of ordinary skill in the art at the time of

Applicant's invention to have modified Coloring.com with the feature Line coloring

changing in Microsoft disclosed by Curts since it would have provided the benefit of the

user to customized a graphic or image based on the user's tastes.

As per independent claim 6, Claim 6 recites similar limitations as in claim 1 and is

similar rejected under rationale. Furthermore, Coloring.com discloses a system:

- a server and a color image software system encoded on one or more

  computer readable media (e.g. FIG 4 discloses a browser connected to a web

  page based on the URL supplied to the browser. It is inherent browser

  connect to servers to download web pages from the servers' data storage

  device to the computer the browser recites, therefore the browser downloads

  the web page (Coloring.com) from a server data storage device and is

  provided to the user computer through the browser. In addition, the interaction

  between the user and the functionality of Coloring.com is a system.)

- supplying at least the element to a user computer for displaying to a user (pp
  8,17 discloses the element being displayed to the user showing the
  combination of the component colors)

As per dependent claim 8, claim 8 recites similar limitations as in claim 1 and is
similarly rejected under rationale.

As per independent claim 10, Claim 10 recites similar limitations as in claim 1
and 6 and is similar rejected under rationale.

As per independent claim 16, Coloring.com recites similar limitations as in Claim
1 6, and 10, and is similar rejected under rationale. Furthermore, Coloring.com
discloses a method comprising:

- receiving electronic product desire information, the information including
  identifiers of a plurality of colors, and (pp 8, 9-16,17-18: Coloring.com
  discloses a palette of colors that enable a user to from on the left. Therefore,
  Coloring.com discloses "receiving electronic product design information" as
  stated)
- processing the received information in the browser program to display an
  electronic product design to a user, the electronic design including at least the
  at least one element, the image content of the at least one element being
  generated by applying a color from the plurality of colors as a component
  color of the grayscale image content of the element.(Using Internet Explorer
  as shown to access Coloring.com, Coloring.com discloses a "electronic

design" that includes an image or graphic that has a color replaced by one of the colors selected from the color palette. (pp 20-22)

As per dependent claim 17, Coloring.com discloses:

- allowing the user of the computer to select a first component color from the plurality of colors, (pp 20, 22 shows a palette full of a plurality of individual selectable colors on the left side in which the user able to select a color)

- after the selection of the first selected color by the user, modifying the product design by applying the first selected color as the first component color, and displaying at least the modified content image to the user. (pp 20-22, 23-25: user selects a color, clicks on the already modified portion of the content of colored filled in from pp 22, wherein pp 25 discloses the new color replacing the old color. pp 20-22 discloses replacing the portion of content that is white with a color from the palette)

As per dependent claim 18, Claim 18 recites similar limitations as in claim 1 and is similar rejected under rationale.

As per dependent claim 20, Claim 20 recites similar limitations as in claim 16 and is similar rejected under rationale.

As per dependent claim 21, Coloring.com discloses allowing the user to place an order for the production of one or more products from the electronic product design. (Coloring.com discloses the ability to request print the electronic design after a color has been replaced or in other words place an order for the production (printed copy) of the

electronic product design. PP 28 shows the a link that enables a user to print the

graphic. Clicking on the link shows pp 29 that shows just the modified image with colors

that were added. (PP 29 shows a screenshot taken on 11/9/2006 to show the complete

and working functionality of the feature within coloring.com that been accessible since

at least November 29, 2002.) Then using the File>Print (shown on pp 30), which pops

up a print dialog box (pp 31), a user can "order" a number of printed copies (products) of

the electronic design.)

As per dependent claim 22, Claim 22 recites similar limitations as in claim 17 and

is similar rejected under rationale. Furthermore, Coloring.com allows a user to select a

new color to replace the existing color that was used to fill in the content. (pp20-22, 23-

25)

12.   Claims 5, 9, 12, and 19 are rejected under 35 U.S.C. 103(a) as being

unpatentable over (Coloring.com (Coloring.com, "Coloring.com - free online interactive

coloring pages and coloring books", pp 1-27, 28-31) in further view of Curts ("Microsoft

Word - Drawing Tools', p1-4, published as early as July 26, 2003) in further in view of

Sams Publishing,("Sams Teach Yourself Microsoft Publisher 2000 in 10 Minutes",

published 5/6/1999, printed pages 1-11, 12-16)

As per dependent claim 5 and 19, Coloring.com discloses the ability to save the

modified graphic or image by right-clicking and saving it to a user's system. (pp 26-27)

However, Coloring.com fails to disclose incorporating the content image into an

electronic product design, displaying the electronic product design to the user, and

allowing the user to place an order for the production of one or more products from the electronic product design. However, Sams Publishing discloses that Microsoft Publisher 2000, hereinafter "Publisher", has the ability to create publication pages that include flyers, postcards etc. (pp 1-7) Thus, a user can create a flyer using the publication wizard, then use the insert picture option. (pp 8-10) Doing so, incorporates the saved modified image from the user's system into Publisher's flyer where it is displayed to the user. In addition, a user can request to print the publication which allows the user to request the publication on paper (product) through the Print options of Microsoft Publisher 2000 (pp 12 –16)

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified Coloring.com's method of coloring grayscale images to include Sam's Publishing disclosure of Publisher that enables a user to incorporate images and graphics into a publication since Sams Publishing's disclosure of Publisher provides the benefit of using Publisher which is an easy-to-use desktop publishing tool that allows a user to create variety types of publications that include importing images or graphics to make it look professional.

As per dependent claim 9, claim 9 recites similar limitations as in claim 5 and is similarly rejected under rationale.

As per dependent claim 12, claim 12 recites similar limitations as in claim 5 and is similarly rejected under rationale.

Response to Arguments

13.   Applicant's arguments with respect to claim 1, 6, 10 and 16 have been

considered but are moot in view of the new ground(s) of rejection.

Arguments addressing in regards of the new limitations of Claims 1, 6, 10 and 16

brought forth in the amendment by adding new multiple limitation resulting in the

changing of scope is now in view of the new ground(s) of rejection of 35 USC 103(a)

under new references using Coloring.com in view of Curts.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to David Faber whose telephone number is 571-272-2751.

The examiner can normally be reached Monday-Thursday, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

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Business Center (EBC) at 866-217-9197 (toll-free).

/David Faber/
Examiner, Art Unit 2178

| | /CESAR B PAULA/ |
| | Primary Examiner, Art Unit 2178 |